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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 08/828, 143 | 03/24/97 | HSIA | H 24400-101 |

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HM31/0717

MARX, I

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1651 | |

DATE MAILED: 07/17/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | | |
|------------------------------|--------------------------------------|-------------------------------|
| Office Action Summary | Application No. 08/828,143 | Applicant(s) Hsia |
| | Examiner Irene Marx | Group Art Unit 1651 |

Responsive to communication(s) filed on May 18, 1998.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-11 is/are pending in the application.
 Of the above, claim(s) 9-11 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-8 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been
 received.
 received in Application No. (Series Code/Serial Number) _____.
 received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892
 Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
 Interview Summary, PTO-413
 Notice of Draftsperson's Patent Drawing Review, PTO-948
 Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

The application should be reviewed for errors. Error occurs, for example, in the spelling of "germentum" and "bifudus" in claim 2.

Applicants' election without traverse of group I, claims 1-8 filed 5/18/98 is acknowledged.

Claims 9-11 are withdrawn from consideration.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1,2, 4, 8 and 9 rejected under 35 U.S.C. 102(b) as being anticipated by Lynn.
Lynn teaches a product containing bacteria, yeast and protein that is dried and stable for at least six months. See, e.g., col. 12, lines 14-24 and col. 11, lines 43-50.

Claims 1,2, 4, 8 and 9 rejected under 35 U.S.C. 102(b) as being anticipated by Gelinas.

Gelinas teaches a product containing bacteria, yeast and protein that is lyophilized. See, e.g., Example 1, 4 and 5.

Claims 1,2, 8 and 9 rejected under 35 U.S.C. 102(b) as being anticipated by Spiller.

Spiller teaches a product containing bacteria, yeast and protein that is dried and stable. See, e.g., bridging paragraph between col. 11 and 12 and Example 2.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynn taken with Gelinas, and Spiller *et al.* and further taken with Jolly, Friend and El-Megeed *et al.*

Each of Lynn, Gelinas and Spiller *et al.* teaches a product containing bacteria, yeast and protein that is dried and stable. See, e.g., Lynn, col. 12, lines 14-24 and col. 11, lines 43-50; Gelinas, Example 1, 4 and 5; Spiller, bridging paragraph between col. 11 and 12 and Example 2.

In addition Jolly and Friend disclose the advantageous combination of whey and soy proteins with bacteria and/or yeasts for nutritional purposes. See, e.g, Friend, page 128; Jolly, col. 3, lines 15-35. Note, in particular, the discussion throughout Friend regarding the numerous benefits of providing *Lactobacillus* biomass for nutritional and therapeutic purposes. Jolly is cited to demonstrate that bacteria, yeasts and soy beans are all excellent sources of protein. (See, e.g., col. 3).

The reference differ from the claimed invention in process parameters such as concentration of bacteria, of yeast and/or of protein, as well as in the specific types of protein used. However, the optimization of conditions identified as result-effective variables cited in the references would have been *prima facie* obvious to a person having ordinary skill in the art. The

respective concentrations would have been adjusted by one of ordinary skill in the art depending on the particular application intended. See, e.g., ElMegeed *et al.* col. 11 for teachings regarding adjustments on the concentration of bacteria, yeast and/or protein.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to modify the process of Lynn, Gelinas, and Spiller *et al.* by adjusting the various parameters, such as the source and concentrations of bacteria, yeasts and protein, as suggested by the teachings of the references, in order to maximize the benefits of consuming healthful sources of protein in combination with the other nutrients provided by microorganisms.

Thus, the claimed invention as a whole was clearly prima facie obvious, especially in the absence of sufficient, clear and convincing evidence to the contrary.

No claim is allowed.

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Group Art Unit 1651**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (703) 308-2922.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Irene Marx
Irene Marx
Primary Examiner
Art Unit 1651